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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/554,343	12/06/2000	Konstanze Saathoff	HHI-023US	2211

7590

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EXAMINER

MEISLIN, DEBRA S

ART UNIT

PAPER NUMBER

3723

DATE MAILED: 04/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/554,343

Applicant(s)

SAATHOFF ET AL.

Examiner .

Debra S. Meislin

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 2/11/02 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The structure and operation of the motor driven manual wrench has not been clearly set forth in view of the specification and drawings. Specifically, the structure of the articulated joint "8", the articulated body "9", the adapter "12", the spring "10", the motor, the torque limiter, the structure of the motorized portion of the device, the cooperation between the manual and motorized portions of the device, and the operation of the each of the above listed elements has not been clearly defined to enable an understanding of the invention.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

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The specification is objected to under 37 CFR 1.71. On page 9, lines 21-24 and 35-36 are not understood. On page 10, lines 4-7 and 20-21 are not understood. The specification lacks a proper reference numeral "11" as set forth in the drawings. The drawings do not appear to disclose a "setscrew".

3. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "motor-driven manual wrench" appears contradictory. The disclosure appears to disclose "a combination motor-driven and manual driven wrench". In lines 4-6, it is not clear as to how the torque limiter is attached to the ratchet drive and to the drive motor in view of the specification and drawings.

Claims 2-3, 7-12, 14-16 are not clearly supported (structurally and operationally) by the specification and drawings.

Lines 3-7 of claim 6 are not understood in view of the specification and drawings.

In claim 14, "a flat" output element is not understood.

4. Normally a claim which fails to comply with the first and/or second paragraph of 35 USC 112, will not be analyzed as to whether it is patentable over the prior art since to do so would of necessity require speculation with regard to the metes and bounds of the claimed subject matter, *In re Steele*, 308 F.2d 859, 862-63, 134 USPQ 292, (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 1385, 496 USPQ 494, 496 (CCPA 1970).

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

REMARKS:

6. Applicant's arguments filed 2/11/02 have been fully considered but they are not persuasive.

Applicant's arguments alone are insufficient to overcome a deficient specification and drawings. The drawings and specification must be amended to provide a clear understanding of the invention. It is strongly suggested that applicant submit additional figures to disclose the various elements of the device including, but not limited to, and exploded view of the device, the structure of the articulated joint "8", the articulated body "9", the adapter "12", the spring "10", the motor, the torque limiter, the motorized portion of the device, the cooperation between the manual and motorized portions of the device, and the operative positions of the device.

The specification must clearly indicate the structure of the device that is old in the art. Applicant's arguments alone are insufficient. An understanding of the invention

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must be ascertained from the original disclosure and not in view of arguments directed to similar cited art.


Applicant refers to illustration "A" and "B". No such illustrations have been received.

All applications must comply with U.S. practice (including under 35 USC 112) regardless of determinations made in PCT applications.

Terminology must comply with the proper use in the English language. Translations must be thorough reviewed and amended such that they clearly define the invention.

The examiner remains of the opinion that the specification and drawings are fatally defective. It is suggested that applicant submit a continuation-in-part application which includes a clear understanding of the invention.

7. Any inquiry concerning this communication should be directed to Examiner Meislin at (703) 308-3671.


D. S. Meislin
Primary Examiner
Group 3720, Art Unit 3723

April 24, 2002